

### REMARKS

This Amendment is submitted in response to the Office Action dated July 2, 2002. In the Office Action, the Patent Office rejected Claims 1-16 and 21. The Patent Office rejected Claims 1-7 under 35 U.S.C. §102(b) as being anticipated by *Main* (U.S. Patent No. 5,618,064). The Patent Office also rejected Claims 4 and 12 under 35 U.S.C. §103(a) as being unpatentable over *Walz* in view of *Petkovsek* (U.S. Patent No. 5,697,648). Further, the Patent Office rejected Claims 8-16 and 21 under 35 U.S.C. §103(a) as being unpatentable over *Main* in view of *Coats et al.* (U.S. Patent No. 5,624,069)

By the present amendment, Applicant amended Claims 1 and 9. Applicant submits that the amendments overcomes the rejections by the Patent Office for the reasons that follow and that the application is now in condition for allowance. Notice to that effect is requested.

Applicant also submits simultaneously herewith a petition to withdraw the finality of the Office Action as premature. In the Office Action dated December 4, 2001, the Patent Office indicated that Claim 12 was objected to, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In response to this Office Action, Applicant added Claim 21 incorporating Claim 12 into Claim 21 as indicated to be allowable by the Patent Office. In the Final Rejection dated July 2, 2002, the Patent Office rejected Claim 21. As a result, the Patent Office has made the

first rejection of Claim 21 a final rejection after stating that the claim would be allowed. Applicant respectfully submits that the Final Office Action was premature and should be withdrawn. Notice to that effect is requested.

As to the rejection of Claims 1-7 under 35 U.S.C. §102(b), Applicant amended Claims 1. Applicant submits that the rejection of Claims 1-7 have been overcome by the amendment to Claim 1 and for the reasons that follow.

Amended Claim 1 requires a mailing assembly for use in connection with the non-domestic delivery of a mailpiece holding contents for delivery thereof comprising a backing sheet that forms a compartment to be adhered to the mailpiece. Claim 1 further requires a mailing form having a mailing label and a receipt card wherein the mailing label is removably attached to the backing sheet by an adhesive. The mailing form is variably printed with information necessary to comply with requirements for delivery of the mailpiece. Claim 1 also requires a mailing form inserted into the compartment to effect non-domestic delivery of the mailpiece. Claim 1 further requires a receipt card having no adhesive backing wherein the receipt card is removably attached to the backing sheet. Claim 1 also requires the receipt card to be detachably connected to the mailing form.

On the contrary, *Main* teaches a packing slip and shipping label for use on a package. The shipping label is removably attached to the back side of the packing slip until the shipping label is ready to use. The shipping label has a top side and a

bottom side. The shipping label is removed from the back side of the packing slip, and the packing slip is folded such that the destination is visible. The shipping label is affixed to the package via an adhesive coating adhered to the shipping label.

*Main* does not teach or suggest a mailing form having a mailing label and a receipt card wherein the mailing label is removably attached to the backing sheet by an adhesive. Further, *Main* does not teach or suggest a mailing form that is variably printed with information necessary to comply with requirements for delivery of a non-domestic mailpiece. Still further, *Main* does not teach or suggest a receipt card without adhesive backing wherein the receipt card is removably attached to the backing sheet. Further, *Main* does not teach or suggest a receipt card that is detachably connected to the mailing label.

Under 35 U.S.C. §102, anticipation requires that a single reference discloses each and every element of Applicant's claimed invention. *Akzo N.V. v. U.S. International Trade Commission*, 808 F.2d 1471, 1479, 1 USPQ 2d. 1241, 1245 (Fed. Cir. 1986). Moreover, anticipation is not shown even if the differences between the claims and the reference are "insubstantial" and one skilled in the art could supply the missing elements. *Structure Rubber Products Co. v. Park Rubber Co.*, 749 F.2d. 707, 716, 223 USPQ 1264, 1270 (Fed. Cir. 1984).

Since *Main* fails to disclose the elements defined in amended Claim 1, the rejection of Claims 1-7 under 35 U.S.C. §102(b) has

been overcome and should be withdrawn. Notice to that effect is requested.

As to the rejection of Claims 8-16 and 21 under 35 U.S.C. §103(a), Applicant amended Claim 9. Applicant submits that the rejection of Claims 8-16 and 21 have been overcome by the amendment to Claim 9 and for the reasons that follow.

Claim 9 requires a mailing assembly for use in connection with non-domestic delivery of a mailpiece having a backing sheet wherein the backing sheet forms an envelope having a compartment. The envelope is adhered to the mailpiece. Claim 9 also requires a mailing form attached to the backing sheet wherein the mailing form is subdivided into a plurality of sub-parts wherein each sub-part is variably printed with information necessary to comply with requirements for non-domestic delivery of the mailpiece. Further, Claim 9 requires that at least one of the plurality of sub-parts is inserted into the compartment.

Claim 21 requires a mailing assembly for use in connection with non-domestic delivery of a mailpiece having a backing sheet wherein the backing sheet is capable of forming an envelope to be adhered to the mailpiece. Claim 21 further requires a mailing form removably attached to the backing sheet wherein the mailing form is subdivided into a plurality of sub-parts. Claim 21 requires that each sub-part is variably printed with information necessary to comply with requirements for non-domestic delivery of the mailpiece. Still further, Claim 21 requires an adhesive layer disposed on the backing sheet wherein the envelope formed

from the backing sheet is formed via the adhesive layer on the backing sheet.

The Patent Office states that *Main* does not disclose a third auxiliary label on the backing sheet wherein the backing sheet forms an envelope having a compartment, and wherein the mailing form is subdivided into a plurality of sub-parts having tear lines wherein one of the sub-parts corresponds to a customs notice. The Patent Office further alleges that *Coates et al.* disclose a mailing assembly comprising a backing sheet forming an envelope formed via the adhesive layer and adhered to a mailing form having sub-parts separated by a tear line.

On the contrary, *Coats et al.* teach an envelope assembly that attaches to a mailpiece and receives various documents. The documents inserted into the envelope assembly taught in *Coats et al.* are not part of the envelope assembly. Rather, the documents must be obtained from outside the envelope assembly. *Coats et al.* do not teach a mailing form subdivided into a plurality of sub-parts having tear lines, wherein the sub-parts are used to mail a non-domestic special service package. *Coats et al.* merely teach indicia located on the envelope assembly. The indicia are not inserted into the envelope compartments as required by Claims 9 and 21. In fact, the indicia located on the envelope assembly are stickers and adhesive backed labels used in the shipping process and for providing instructions on using the envelope assembly. These stickers and labels are not provided for use as shipping documents to be placed inside the envelope assembly.

Further, *Coates et al.* do not teach or suggest a mailing form having sub-parts capable of adhering to a mailpiece.

The Patent Office provided absolutely no teaching whatsoever as to why one having ordinary skill in the art would have combined *Main* with *Coats et al.* as applied by the Office Action in the rejection under 35 U.S.C. §103(a) by providing a mailing assembly as required by the present invention.

Moreover, a person of ordinary skill in the art would never have been motivated to combine *Main* with *Coats et al.* in the manner suggested by the Patent Office in formulating the rejections under 35 U.S.C. §103(a). Applicant respectfully submits that amended Claim 9 and amended Claim 21 distinctly define the present invention from *Main* or *Coats et al.*, taken singly, or in combination.

It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. In re Simon, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most if not all elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of all of the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made.

Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's invention, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

With the analysis of the deficiencies of the *Main* and *Coats et al.* patents in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have been led to combine *Main* with *Coats et al.* to produce the claimed invention. Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103.

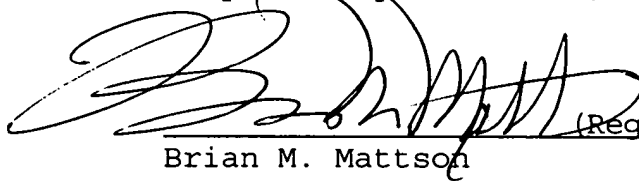
In view of the foregoing remarks and amendments, Applicant respectfully submits that the rejection under 35 U.S.C. §103(a) has been overcome and should be withdrawn. Notice to that effect is requested.

Claims 2-8 depend from Claim 1; and Claims 10-16 depend from Claim 9. These claims are further believed allowable over the references of record for the same reasons set forth with respect to their parent claims since each sets forth additional structural elements of Applicant's mailing assembly.

In view of the foregoing remarks and amendments, Applicant respectfully submits that all of the claims in the application

are in allowable form and that the application is now in condition for allowance. If, however, any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue. Applicant requests the Patent Office to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,

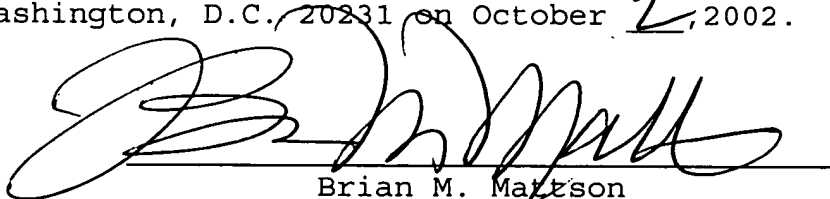


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**CERTIFICATE OF MAILING**

I hereby certify that this **AMENDMENT AFTER FINAL** is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to the Asst. Commissioner for Patents, **Box AF**, Washington, D.C. 20231 on October 2, 2002.



Brian M. Mattson



VERSION WITH MARKS TO SHOW CHANGES MADE

Please amend Claim 1 as follows:

1. (Amended) A mailing assembly for use in connection with a non-domestic delivery of a mailpiece holding contents for delivery thereof, the assembly comprising:

a backing sheet wherein the backing sheet forms a compartment to be adhered to the mailpiece;

a mailing form [with no adhesive backing] having a mailing label and a receipt card wherein the mailing [form] label is removably attached to the backing sheet by an adhesive and further wherein the mailing form is variably printed with information necessary to comply with requirements for delivery of the mailpiece wherein the mailing form is inserted into the compartment to effect non-domestic delivery of the mailpiece and further wherein the receipt card has no adhesive backing and wherein the receipt card is removably attached to the backing sheet and is detachably connected to the mailing label.

Please amend Claim 9 as follows:

9. (Amended) A mailing assembly for use in connection with non-domestic delivery of a mailpiece, the assembly comprising:

a backing sheet wherein the backing sheet forms an envelope having a compartment wherein the envelope is adhered to the mailpiece; and

a mailing form [with no adhesive backing wherein the mailing form is] removably attached to the backing sheet wherein the mailing form is subdivided into a plurality of sub-parts wherein

each sub-part is variably printed with information necessary to comply with requirements for non-domestic delivery of the mailpiece and further wherein at least one of the plurality of sub-parts is inserted into the compartment.